

differences of the new claims from the original claims is not pointed out. See 37 CFR 1.175(a)(1) and MPEP §1414.

We respectfully disagree that the declaration filed with the application is defective for the reasons given by the Examiner, because the declaration clearly meets the criteria set forth in of 37 CFR 1.175 and the relevant sections of the Manual of Patent Examination and Procedure (MPEP). Specifically, we turn first to the Examiner's reasoning that the declaration fails to identify at least one error which is relied upon to support the reissue application. As set forth in the MPEP at §1414(II),

"A change or departure from the original specification or claims represents and 'error' in the original patent under 35 U.S.C. 251. See MPEP §1402 for a discussion of grounds for filing a reissue that may constitute the 'error' required by 35 U.S.C. 251."

As set forth in the MPEP at §1402,

"[t]he most common bases for filing a reissue application are: (A) the claims are too narrow or too broad. . . . An attorney's failure to appreciate the full scope of the invention was held to be an error correctable through reissue in In re Wilder, 736 F.2d 1516, 22 USPQ 369 (Fed. Cir. 1984)."

On page 2 of the declaration, we have provided verbatim statements to this effect in the declaration. Our declaration states:

"We believe that through error, without any deceptive intent, the '720 patent is partially inoperative or invalid by reason of the patentee claiming more or less than the patentee had the right to claim in the patent. In particular, there is a possible defect in independent claim 1 as issued, in that it is unduly narrow and not commensurate in scope with the description in the specification and what we believe our invention to encompass. Because it is unduly narrow, it may impact the scope of all other claims 2-18 which depend directly or indirectly on one of claim 1. . . . Therefore, by reason of the above-described errors, claims presented in original Patent 5,783,720 are possibly not broad enough to cover all aspects of the invention disclosed in the patent. The possible unduly narrow scope of the claims resulted from a failure by ourselves, the assignee and counsel to realize that the claims did not cover all that was intended to be covered as set forth in the specification."

Thus, our declaration identifies the errors relied upon in the manner specifically indicated as acceptable in the MPEP. There is no additional requirement that the declaration contain a discussion identifying the specific changes to the claims and the differences of the new claims from the original claims. Consequently, our declaration meets the criteria

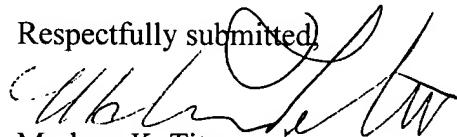
set forth in the Code of Federal Regulations and the Manual of Patent Examination and Procedure, and nothing further is required.

The Examiner also objected that the reissue oath/declaration is defective because the address listed beside each inventor's name is referred to as the residence address rather than the Post Office address. To deal with this, and as suggested by the Examiner in today's telephone discussion, we submit here an Application Data Sheet pursuant to 37 CFR 1.76, by which the post office (or mailing) addresses of each inventor is set forth. This is believed to be sufficient to resolve the issue, and reconsideration is requested.

Claims 2-23 are rejected as being based upon a defective reissue declaration. However, because the declaration is not defective reconsideration of this rejection is also requested.

This reissue application is believed to be in condition for allowance, and notice to that effect is earnestly solicited. If the Examiner has any further inquiries about the issues discussed hereinabove, or any other issue relating to this application, he is invited to contact Applicants' representative, the undersigned, at (301) 924-9600.

Respectfully submitted,


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